



Dkt. 1769/41426-D/JPW/CY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Ron S. Israeli et al.
Serial No.: 08/470,735 Examiner: S. Gucker
Filed : June 6, 1995 Group Art Unit: 1647
For : PROSTATE-SPECIFIC MEMBRANE ANTIGEN

1185 Avenue of the Americas
New York, NY 10036
July 20, 2004

Date of Notice

Of Allowance: April 20, 2004

Confirmation No.: 7764

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP ISSUE FEE

Sir:

COMMENTS ON EXAMINER'S STATEMENT OF REASONS FOR ALLOWANCE
PURSUANT TO 37 C.F.R. §1.104(e)

Applicants herein comment on the Examiner's Reasons For Allowance included as paragraph 2 on page 4 of the Notice of Allowability issued on April 20, 2004 by the United States Patent and Trademark Office in connection with the above-identified application. A Notice of Allowance was also issued on April 20, 2004, and the deadline for paying the issue fee is July 20, 2004. Accordingly, these Comments On Examiner's Statement Of Reasons For Allowance are timely submitted.

In the Examiner's Statement of Reasons for Allowance on page 4, paragraph 2 of the April 20, 2004 Notice of Allowability, the Examiner indicated that the request by applicants to put the

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subject application into interference with U.S. Patent No. 6,107,090, issued August 22, 2000 (U.S. Serial No. 08/838,682) has been rendered moot with the cancellation of claim 139. The Examiner also indicated that according to the prosecution history of U.S. Patent No. 6,107,090, the claim limitation that an antibody or antigen binding portion of said antibody is selected for its ability to bind to live cells (see claim 1 of U.S. Patent No. 6,107,090) distinguishes that invention as "being patentably the same invention as the instant invention." The Examiner further stated that the claims of U.S. Patent No. 6,107,090 are therefore a sub-genus of the instant claims, and there is no art or reason of record that renders the patented sub-genus claims obvious over the instant generic claims, thereby failing the "two-way" test required in order to propose the establishment of an interference.

In response, applicants note that although they are not currently claiming the same patentable subject matter in the above-identified application as was patented in U.S. Patent No. 6,107,090, they do not agree that the claims of U.S. Patent No. 6,107,090 are patentably distinct from the subject matter disclosed but not claimed in the subject application which in turn has a content identical to that of applicants' PCT International Application No. PCT/US93/10624, filed November 5, 1993, International Publication No. WO 94/09820, published May 11, 1994, i.e., more than one year prior to the earliest filing date, i.e., May 6, 1996, claimed in U.S. Patent No. 6,107,090. Applicants maintain that cancelled claim 139 in the subject application was allowed because the subject application supports such claim and U.S. Patent No. 6,107,090 is not prior art as to the subject application. Therefore,

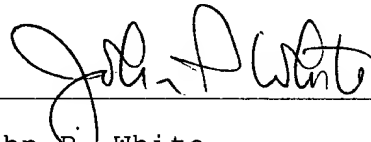
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U.S. Patent No. 6,107,090 is not patentable over the disclosure of applicants' International Publication No. WO 94/09820.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of these Comments. If any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

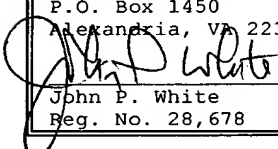
Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

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 7/20/04
John P. White Date
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